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THOMAS J. BUSH, III
2022 TAFT STREET
GARY, IN 46404

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OFFICE OF PETITIONS

In re Application of	:	
BUSH	:	
Application No. 09/815,794	:	ON PETITION
Filed: March 23, 2001	:	
Attorney Docket No. (None)	:	

This is a decision on a renewed petition under 37 CFR 1.137(a), filed April 6, 2005 and supplemented April 25, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to file a timely reply within the meaning of 37 CFR 1.113 to the final Office action of November 26, 2003, which set a shortened period for reply of 3 months. As the replies filed March 2, 2004 and April 9, 2004 had no extensions of time fee¹, this application became abandoned at midnight on February 26, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

As for requirement (3), Petitioner ("Bush") appears to contend in the original (July 12, 2005) and the renewed petitions (April 6 and 25, 2006) that a timely and proper reply to the final rejection of November 26, 2003 was submitted to the Office and that the abandoned status of the above-identified application is improper. Bush also argues the delay in responding to the final rejection was unavoidable because of his health and his financial condition.

¹ The examiner had no procedural authority with respect to this abandoned application on or after February 27, 2004. *Lorenz v. Finkl*, 333 F.2d 885, 891 142 USPQ 26, 30 (CCPA 1964). It follows that an Advisory Action should not have been mailed on July 21, 2004 since the examiner was without authority.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of the mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting *Pratt*, 1887 Dec. Comm'r Pat. 31, 3233 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A review of the record makes it immediately apparent that Petitioner is not well versed in patent practice and procedure. Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper reply, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. In the present situation, the record reflects that Bush made several attempts to file an amendment after final action with the Office in response to the November 26, 2003 final action. The first submission on February 7, 2004 was returned to Bush in a letter dated February 23, 2004. Bush also admits in an April 9, 2004 submission to the Office that the correspondence of February 7, 2004 failed to identify Application No. 09/815,794

and was returned.² The resubmitted amendment was filed on March 2, 2004 (often referred to by Bush as the February 27, 2004 response), which was outside of the three-month period set forth in the November 26, 2003 final action and required an extension of time fee for one month.³ As stated above, no fee was submitted with the response. Yet another amendment was filed on April 9, 2004,⁴ which did not include but required an extension of time fee for two months. As such, the responses filed with the Office after final action were not timely.

While the examiner had no procedural authority to act on the application on or after February 27, 2004 since it was abandoned, the Advisory Action mailed July 21, 2004 also indicated that the amendment(s) did not place the application in condition for allowance. A proper reply under 37 CFR 1.113 to the final action must have included one of the following: (a) a Notice of Appeal and appeal fee; (B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance; (C) the filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee) under 37 CFR 1.114; or (D) the filing of a continuing application under 37 CFR 1.53(b). Bush did not submit one of the above-provided proper replies within the period set in the final action or within the six-month statutory period along with any necessary extension of time fees. The application, therefore, properly went abandoned.

Likewise, as a “reasonably prudent person” would file papers or fees in compliance with 37 CFR 1.8 or 1.10⁵ to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant’s failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute “unavoidable” delay. *See Krahn v. Commissioner*, 15 USPQ2d 1823, 1825, (E.D. Va 1990); *see also* MPEP 711.03(c)(III)(C)(2). Bush’s responses (e.g., the February 9, 2004, the March 2, 2004, and the April 9, 2004 responses) did not include any certification and thus did not get the benefits of any paper filed in compliance with 37 CFR 1.8 and 1.10.

Finally, a delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered “unavoidable” due to: (A) the applicant’s reliance upon oral advice from USPTO employees; or (B) the USPTO’s failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See

² This procedure is consistent with 37 CFR 1.5, which states that correspondence “must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 09/815,794), or the serial number and filing date assigned to that application by the Patent and Trademark Office[.]” 37 CFR 1.5 further states “[a]ny correspondence not containing such identification will be returned to the sender where a return address is available.”

³ 37 CFR 1.136(a) allows Applicants to buy an extension of time up to the maximum extendable period set by statute. 35 U.S.C. 133 gives applicants six-months to response to a final action.

⁴ Applicant makes reference to a March 9, 2004 submission in the April 6, 2006 petition. However, no March 9, 2004 submission has been located. It is believed that Applicant meant to refer to the April 9, 2004 submission.

⁵ A certificate of mailing permits Applicants to certify that the correspondence was “[a]ddressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail.” A certificate of transmission permits Applicants to certify that the correspondence was “[t]ransmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d).”

In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985). Therefore, any delay caused by the failure of the Office to advise Bush on the status of the after-final amendment until the mailing of the Advisory Action on July 21, 2004, which fell outside of the six-month period for reply set forth by 35 USC 133, will not be considered unavoidable. Additionally, any delay resulting from Applicant failing to be notified that an extension of time fee was due with the March 2, 2004 or the April 9, 2004 responses, will not be considered unavoidable for purposes of 37 CFR 1.137(a).

With respect to applicant's health, Petitioner asserts incapacitation (his disability) as a cause of the delay. A showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such nature and degree as to render petitioner unable to conduct business (e.g., correspond with the Office) during the period between November 26, 2003 and May 26, 2004. A statement from petitioner's treating physician must support such a showing, and such statement must provide the nature and degree of petitioner's incapacitation during this above-mentioned period. Bush appears to have provided evidence that he underwent surgery for a herniated disk (microlumbar discectomy) in July, 2003, but no documentation from his treating physician providing the nature and degree of Bush's incapacitation during the above-mentioned period has been provided. Even more importantly as evidenced by the filings in February, March and April of 2004, Bush had the ability to file various responses to the November 26, 2003 final action, and his "incapacitation" did not prevent him from conducting business with the Office. The present facts do not demonstrate that Bush's health problems caused the response to the final action to be "unavoidably" delayed within the meaning of 35 USC 41(c)(1).

With respect to applicant's financial situation, Petitioner asserts that he is "very poverty stricken." A showing of unavoidable delay based upon financial condition must establish that the financial condition of the petitioner during the entire period of the delay was such as to excuse the delay. *See Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). The present showing of record does not adequately establish that petitioner's entire delay in responding to a final action was unavoidable within the meaning of 37 CFR 1.137(a). Prior to February 27, 2004, Bush had the option to submit a timely reply to the November 26, 2003 final action without any fee. For this period, any argument of unavoidable delay in filing an amendment to the final action based on his financial condition is not relevant. During the period from February 27, 2004 through May 26, 2004, Bush has not demonstrated that petitioner was unable to pay the extension of time fee due with the March 2, 2004 or the April 9, 2004 submission or to pay any fees associated with the filing of a continuing application, a request for continued examination or a notice of appeal along with any necessary extensions of time. As such, Bush has not shown to the satisfaction of the Director that the entire delay in responding to the November 26, 2003 final action for purposes of 37 CFR 1.137(a) was unavoidable.

Also while resources would have been necessary to employ the assistance of counsel in continuing the prosecution of the above-identified application, persons seeking patent rights have no "right" to the assistance of counsel during the application process. *Boyden v. Commissioner of Patents*, 441 F.2d 1041, 168 USPQ 680 (D.C. Cir. 1971). As patent applications are commonly prosecuted *pro se*, arguments that the financial inability to employ counsel to aid in

the prosecution of an application rendered the abandonment of the application “unavoidable” are unpersuasive. That is, while applicants may obtain the services of counsel to assist in the application process, such counsel is not strictly necessary, and, as such, the financial inability to employ such counsel does not render a delay in providing a required response “unavoidable.”

If petitioner decides to pursue demonstrating that the delay in timely filing a response to the November 26, 2003 final action was unavoidable based on financial difficulties, a complete showing of the financial condition of petitioner, with supporting documentation, is required. Such showing should include all income, expenses, assets, credit, and obligations, which made the delay from November 26, 2003, until the filing of the original petition on July 12, 2005, “unavoidable.” A monthly breakdown is preferred. In essence, petitioner must show that he was aware of the need to file a proper response to the final action, but when any fees came due, was financially unable to make the payment throughout the period in question until the petition was filed.

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Please be advised that the decision on petition, however, will be rendered only the information provided. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14).

If Petitioner decides to pursue the petition process, Petitioner should consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the \$ 750 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

If petitioner elects not to pursue the petition process, the notice of appeal fee (\$250) will be refunded upon request.


Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787


Frances Hicks
Petitions Examiner
Office of Petitions